

DOCKET NO. 2328-059

U.S. PATENT APPLN. NO. 10/032,279

REMARKS

Applicants note the indication of claims 74 and 75 containing allowable subject matter.

To obviate the rejection of claims 21, 29, 30, 33, 40 and 41, under 35 U.S.C. § 112, second paragraph, Applicants change the word "another" in these claims to --first--, as the Examiner suggests.

Entry of the Amendment is in order because it is directed only to formal matters and has no substantive effect on the issues. The Amendment does not require a new search and was suggested by the Examiner.

There is no need to amend claims 24, 27-30, 33, 35 or 38-41 to obviate the rejection thereof under 35 USC §112, second paragraph. This is because the words "the electrode" are always followed by the adjective clause "for carrying the workpiece" which has antecedent basis.

The rejection of claims 27-30 and 38-40 under 35 U.S.C. § 112, second paragraph, is incorrect. The Examiner says it is unclear how "the excitation region geometry" relates to current flow. She also says it is unclear what structure is required to achieve the claimed geometry. Paragraph 14, page 8 of the Office Action refers to *In re Schreiber*, 128 F.3d 1473 1477-78, 44 USPQ2d 1429,1431-32 (Fed. Cir. 1997), *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). However, these decisions have nothing to do with 35 U.S.C. §112, second paragraph, but are concerned with the application of 35 U.S.C. §§ 102 and 103 to claims.

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The Office Action ignores Applicants' citation of In re Swinehart, 439, F2d 210, 169 USPQ 226 (CCPA 1971) which indicates that functionality is not a proper basis for rejection of apparatus claims under 35 U.S.C. § 112, second paragraph. In the Swinehart case, the functional language, relating to the opacity of material to optical energy, was the point of novelty over the prior art. The Court ruled the claims conformed with 35 U.S.C. § 112, second paragraph; see MPEP 2173.05(g).

In response to the comments in the Office Action about how geometry relates to current flow, the specification has considerable discussion of this feature. In this regard, see paragraphs 18 and 31 for the features of claim 27 and 28, and paragraphs 32, 51 and 52 for the features of claims 29, 30, 39 and 40. Applicants are entitled to a broad statements regarding the relationship of the excitation region geometry and the function that geometry provides, based on the Swinehart decision.

The rejection of claims 21, 23-25, 27-31, 33-36, 38-42, 44-48, 66 and 70 as being unpatentable over Li et al. (USP 6,178,919) in view of Lenz (USP 5,998,932) is wrong. Independent claims 21 and 33 include the requirements for (1) a first surface at a reference potential to be between the louvers and the electrode for carrying the workpiece and (2) a second surface at the reference potential to be located between the louvers and the first electrode. The office action fails to mention this limitation in analyzing claims 21 and 33. The feature is not disclosed by either Li et al. or Lenz. Consequently, the rejections of claims 21 and 33, as well as the claims dependent thereon (which are rejected as being obvious as a result Li et al. and Lenz), are wrong.

The rejection of independent claim 44 ignores the requirement for a third electrode to be entirely in the excitation region, a feature not disclosed by either Li et al.

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or Lenz. Hence, contrary, to the paragraph bridging pages 8 and 9 of the office action, claim 44 requires the third electrode to be within the excitation region. Clearly, electrode portions 334(a) and 334(b) and rings 22 of Lee et al. are not entirely within a confinement region. Because claim 44 is improperly rejected on Li et al. and Lenz, the claims dependent thereon (which are rejected as being obvious as a result of Li et al. and Lenz) are improperly rejected.

The rejection of claims 32 and 43 as being obvious from Li et al., Lenz and Nakano et al. (USP 6,270,618) is incorrect. These claims depend on claims 21 and 33 and are allowable for the same reasons advanced *supra* with regard to claims 21 and 33. Nakano et al. obviously fails to cure the previously noted deficiencies in the rejection of claims 21 and 33.

The rejection of claims 49-51, 67-69 and 71-73 as being obvious as a result of Li et al., Lenz and Lenz et al. (USP 5,534,751) is wrong. These claims depend on any of claims 21, 33 or 44 and are patentable for the same reasons advanced for claims 21, 33 and 44. Lenz et al. fails to cure the previously noted deficiencies in the rejection of claims 21, 33 and 44.

In view of the foregoing amendments and remarks, entry of the Amendment and Allowance are respectfully requested and deemed in order.

Early issuance of a Notice of Allowance is courteously solicited.

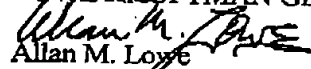
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Respectfully submitted,

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